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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,319	07/09/2003	Bruce Schwoegler	MYSKY-102J	9358

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EXAMINER

MCELHENY JR, DONALD E

ART UNIT PAPER NUMBER

2857

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/615,319	SCHWOEGLER, BRUCE	
	Examiner	Art Unit	
	Donald E. McElheny, Jr.	2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07-09-2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07-09-03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. It is noted that this application claims priority and is stated as a divisional application of prior Application No. 09/752,347, filed 12/29/2000. Such requires a proper and timely submitted reference to the prior application that must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Also, the current status of all nonprovisional parent applications referenced must be included. The instant application fails in such requirements.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of

any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

2. The specification is objected to for the following reasons.

The specification lacks a proper and timely submitted amendment to the written specification for priority purposes as set forth supra. Thus the claim for priority must be denied, and any reference deleted. Currently an incorrect and improper is made later in the specification, not the first sentence of the specification, and fails to comply with the rules and regulations for grant of any claim for priority. The later incorrect (non-copending for one reason) reference of a claim for priority must be deleted in response to this Office action. Note, however, that applications and patents related to the instant claimed invention should be properly referenced at the beginning of the written specification. See 37 CFR 1.77(b), 37 CFR 1.78, and MPEP § 201.11.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 2-4 are rejected under the judicially created doctrine of double patenting over claim 1+ of U. S. Patent No. 6,590,529 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The instant claims delete subject matter of the patented claims and are thus broader in scope for claims 3 and 4, and claim 2 is a rephrasing of the same concepts found claimed in the patented independent claims 1, 18 and 19, and inherently drawn to same concepts as the basis of these claimed features finds the same basis in the respective disclosures of the instant application and the patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

5. Claims 2-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1+ of U.S. Patent No. 6,590,529.

See the above remarks. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to delete subject matter from the issued claims, and/or to rephrase the identical concepts in different linguistic manner without deviating from the core same claimed features of the issued claims in the patent.

6. While applicant states the instant application is a divisional of the parent application which issued as the above noted patent, with the exception of claim 1 of the instant application corresponding to cancelled claim 36 of the parent issued application, the instant claims 2-4 are not drawn to the subject matter of these other noted claims 1 and 36. But are drawn to the same subject matter of the parent issued application and appear not directed to the subsystem of claim 1 and non-elected invention of the parent application. A Terminal Disclaimer is thus required if applicant insists upon pursuing further claims 2-4, and their subject matter, in the instant application. Since these claims 2-4 are not patentable, for reasons the examiner sets forth below after having acted upon the merits of more specific claim 1, the instant Office action includes an action upon the merits of all pending claims as far as any meaningful invention is set forth and can be determined.

7. The abstract of the disclosure is objected to because it states nothing more than the well known state of the prior art at the time of filing (including the filing dates of the alleged parent applications), and no inventive novelty if such can be found supported

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and shown in any claims of the instant application. Correction is required. See MPEP § 608.01(b).

8. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims appear to be nothing more than desired in intended use, incomplete, and fail to point out what is included or excluded by the claim language. They appear to be nothing more than an omnibus type claim.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the published application US 2001/0030624 A1.

13. Claims 1-4 are rejected under 35 U.S.C. 102((a),(b) and (e) as being clearly anticipated by Hoffberg (6,252,544).

Note that the provision of weather services inherently meets the existence of computerized data processing services for provision of weather forecasts for the region affecting the mobile user. Nevertheless, the altering of weather related event data based upon time passing or due to seasonal changes affecting the user's location would also meet such weather forecast data dissemination features. Also note the potential relevance of this patent with respect to the parent issued patent; though both were issued by the same examiner, he may not have been aware of this document during prosecution of the parent application.

14. Claims 1-4 are rejected under 35 U.S.C. 102(a), (b) and (e) as being clearly anticipated by any of the patents to McGraw et al. (5,628,050), Baron, Sr. et al. (6,018,699), Baxter, Jr. (6,023,223), Lemelson et al. (6,084,510), Kennedy, III et al. (6,167,255), Koeller (6,297,766), or Marko et al. (6,347,216) as far as any meaningful statutory subject is set forth.

Each of these references teach a portable user unit that receives weather forecast data tailored for the geographic location the user is located. Whether explicitly

stated or not, computer data processing systems provide the weather prediction criteria for the plural user locations, and while "server" is met by any system providing the information the more detailed definition of a network type server is still inherent as such would be included in the taught computer network communications systems supporting these weather alert systems.

15. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:


It was not executed in accordance with either 37 CFR 1.66 or 1.68.

Since the instant application lacks a proper basis for grant of the claim for priority, the submission of a copy of an earlier application's oath/declaration is improper for submission of a separate and new application. A new oath/declaration is required in response to this Office action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald McElheny Jr., whose telephone number is (571) 272-2218.

Fax transmissions may be directed to (703) 872-9306.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Marc Hoff, can be reached at (571) 272-2216.


DONALD E. McELHENY, JR.
PRIMARY EXAMINER